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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
ARAQUE JR, GERARDO	
ART UNIT	PAPER NUMBER
3629	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/27/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/024,333	RUBINSTENN ET AL.	
	Examiner	Art Unit	
	Gerardo Araque Jr.	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-48* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-48* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. **Claims 31 – 32** are rejected under 35 U.S.C. 102(b) as being anticipated by **Kenet et al. (US Patent 5,291,889)**.

4. In regard to **claims 31 – 32**, **Kenet** discloses a computer for receiving a representation in memory **(Column 4 Lines 19 – 21)**, a database for storing information (inherently included in a computer system), a processor (inherently included in a computer system) for modifying the representation **(Column 3 Lines 1 – 4)**, and a driver (display) for outputting the prognosis **(Column 3 Lines 27 – 29)**.

5. **Claim 47** is rejected under 35 U.S.C. 102(b) as being anticipated by **Linford (US Patent 6,081,611)**.

6. In regards to **claim 47**, **Linford** discloses a memory for receiving data, secondary storage for storing data, a database containing data, processor for rendering, modifying, and generating an image **(Column 5 Lines 30 – 36)** and driver for outputting an image **(Column 5 Lines 47 – 48)**.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. **Claims 1 – 4, 6 – 24, 27 – 29, and 33 – 48** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kenet et al. (US Patent 5,291,889)** in view of **Proactiv** (http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php).

9. In regard to **claim 1 and 48**, **Kenet** discloses a method and system of determining a prognosis for an external body condition comprising receiving a representation of a subject's external body condition **(Column 1 Lines 57 – 60)**, a database for storing information **(Column 2 Lines 67 – 68)**, generating a prognosis after use of a beauty product based on the representation and information **(Column 1 Lines 46 – 47; Column 3 Lines 25 - 29)**, and outputting the prognosis to enable the subject to receive the prognosis **(Column 3 Lines 25 – 29)**. However, Kenet fails to explicitly show "...maintaining in a database information of how using a beauty product affects the evolution of an external body condition."

Proactiv, however, does show how the use of a beauty product affects the evolution of an external body condition (http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php) in a database.

Therefore, it would have been obvious to one having ordinary skill in the time of the invention to modify Kenet in view of the teachings of Proactiv to include information on how the use of a beauty product affects the evolution of an external body condition in order to better inform and demonstrate to a user of the products effects.

10. In regards to **claim 2**, **Kenet** discloses that the representation defines the external body condition **(Column 1 Lines 46 – 47)**.

11. In regards to **claim 3**, **Kenet** discloses that the representation defines an image representation of the external body condition **(Column 2 Lines 57 – 60)**.

12. In regards to **claim 4**, **Kenet** discloses a prognosis image **(Column 3 Lines 25 – 29)**.

13. In regards to **claim 6**, it is inherently implied by **Proactiv** that instruction relating to obtaining instructions to obtaining a representation is included since they have pictures of people who have used the product (http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php).

14. In regard to **claims 7 and 34**, **Kenet** discloses a digitized video image as being the representation of the subject **(Columns 2 – 3 Lines 68; 1)**.

15. In regard to **claims 8 and 35**, **Kenet** and **Proactiv**, in combination as discussed above, disclose constructing an image based on the representation **(Column 3 Lines 1 – 4**;
http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php,
http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php,
http://web.archive.org/web/20010215033109/www.proactiv.com/how/how.php).

16. In regards to **claim 9**, it is implied in **Kenet** that image morphing information must be included in order to make the representative image.

17. In regards to **claim 10 and 37**, it is old and well known in the art to send representations of an individual through the postal service.

18. In regard to **claims 11 and 38**, **Kenet** discloses the usage of digital images, which would imply requiring a storage device. Furthermore, as can be seen by the "Real Stories" section, the data storage device having the representation had to be received in order for the present images to be displayed on the website (http://web.archive.org/web/20010617232049/www.proactiv.com/realstories/real.php).

19. In regard to **claim 12 and 39**, **Kenet** discloses the using before and after images of individuals when testing cosmetics. It would have, therefore, been obvious to one having ordinary skill in the art at the time of the invention to a subset of information relating to differing beauty products given that the organization selling the products have more than one product in their line.

20. In regards to **claim 13 and 40**, **Proactiv** discloses displaying product information (http://web.archive.org/web/20010215033109/www.proactiv.com/how/how.php).

21. In regard to **claim 14 and 41**, **Proactiv** discloses a database with subsets of information on using a beauty product (http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php, http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php).

22. In regard to **claim 15 and 42**, it would have been obvious to one having ordinary skill in the art to print out the information pages provided by **Proactiv**.

23. In regard to **claim 16 and 43**, **Proactiv** discloses different manners of using the products (http://web.archive.org/web/20010215020151/www.proactiv.com/faq/faq3.php, http://web.archive.org/web/20010215020034/www.proactiv.com/faq/faq4.php).

24. In regard to **claims 17 – 19**, the fact that the applicant discloses various embodiments of the beauty products does not change the function of how the method works. The combination of **Kenet** and **Proactiv** disclose the usage of cosmetics and beauty products and their effects.

25. In regard to **claim 20 and 44**, **Proactiv** discloses purchasing the beauty products (http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php)

26. In regard to **claim 21 and 45**, as best understood by the examiner, **Kenet** discloses generating a prognosis comparing the representation with information in the database and selecting a portion of the information based on the comparing **(Column 2 Lines 23 - 26)**.

27. In regard to **claim 22 and 46**, **Proactiv** discloses transmitting the prognosis via a network (http://web.archive.org/web/20010411110515/www.proactiv.com/products/products.php)

28. In regard to **claims 23 – 24**, it is inherently implied by **Proactiv** that if a consumer were to finish one of the three products available in the set that they would have the option of ordering only one of the three products as oppose to buying all three and always having an incomplete set before the new set is set out after a predetermined time period.

29. In regards to **claim 36**, **Kenet** discloses that the representation defines an image representation of the external body condition **(Column 2 Lines 57 – 60)**. It is further implied in Kenet that image morphing information must be included in order to make the representative image.

30. **Claims 5 and 25 – 30** are rejected under 35 U.S.C..103(a) as being unpatentable over **Kenet et al. (US Patent 5,291,889)** in view of **Proactiv** (http://web.archive.org/web/20010521145551rn_1/www.proactiv.com/index.php) and in further view of **Linford et al. (US Patent 6,081,611)**.

31. In regards to **claim 5**, **Linford** discloses rendering the prognosis on a three-dimensional image (Column 25 Lines 25 – 27).

32. In regards to **claim 25**, **Linford** discloses rendering the prognosis on a three-dimensional image **(Column 25 Lines 25 – 27)**. Furthermore, it is implied that a three-dimensional image contains a mesh (polygons) in order to properly and accurately modify a three-dimensional image.

33. In regards to **claim 26**, **Linford** discloses generating a mathematical model corresponding to a three-dimensional mesh image **(Column 25 Lines 36 – 44)**.

34. In regards to **claim 27**, **Kenet** and **Proactiv** are discussed above, however, they fail to teach enabling modification of a representative image based on an input by the subject.

Linford, however, does teach a similar method and system for a prognosis based on the effects of a beauty product. Furthermore, Linford also teaches

manipulating a patient's image in response to feedback provided by the patient **(Column 4 Lines 5 – 14)**.

Therefore, it would have been obvious to one having ordinary skill in the time of the invention to modify the combination of Kenet and Proactiv in view of the teachings of Linford to have a means of manipulating a patient's image in response to feedback provided by the patient.

35. In regards to **claim 28**, **Linford** discloses the modifications of wrinkles from the image representative **(Column 24 Lines 66 – 67)**.

36. In regards to **claim 29**, **Linford** inherently implies that at least one parameter associated with a mathematical model for the modification of wrinkles from the image representative **(Column 25 Lines 19 – 44)**.

37. In regards to **claim 30**, it is inherently implied that a parameter must be modified from the mathematical model in order to generate a prognosis.

Response to Amendment

38. Applicant's arguments filed 10/18/2006 have been fully considered but they are not persuasive.

Claim Objections

39. Claim objections made towards **claims 3 and 28 – 29** are withdrawn due to amendments.

Rejections under 35 USC § 112

40. Rejections made towards **claims 1 – 30, 32 – 46, and 48** are withdrawn due to amendments/applicants' response.

Rejection of Claims 31 – 32 and 47under 35 USC § 102(b)

41. In response to applicant's argument that, "information of how use of at least one beauty produce affects evolution of [an] external body condition," a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The applicant is only disclosing a database that is holding data/information and a processor that is using the stored data/information to produce some output. Kenet et al. and Linford both disclose a system that is capable of storing data/information in a database with a processor that reads the data/information stored.

Rejection of Claims 1 – 30 and 33 – 48 under 35 USC § 103(a)

42. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

As the examiner has already discussed above, Kenet discloses a system that allows before and after photographs of skin to show the benefits of a treatment (Col. 1 L. 45 – 47). While Proactiv discloses how the use of a beauty product affects the evolution of an external body condition, such as acne. Using the teachings of both Kenet, regarding the compilation of images to demonstrate the evolution of the effects

of a skin treatment, and Proactiv, regarding the information on how the use of their product combats acne, it would have been obvious to one skilled in the art that by combining both teachings would have produced applicants' claimed invention of, "generating at least one prognosis reflecting predicted changes in the external body condition after use of said at lest one beauty product." Further still, Linford discloses that the use of three-dimensional imaging is an old and well known art and that combining it with the teachings of both Kenet and Proactive would also have been obvious to one skilled in the art in order to provide the patient/customer with a more detailed and informative image of predicted changes of using a beauty product.

Conclusion

43. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerardo Araque Jr. whose telephone number is

(571)272-3747. The examiner can normally be reached on Monday - Friday 8:30AM - 4:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GA
12/19/06

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